

**REMARKS**

The Official Action mailed August 30, 2011, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on June 19, 2006; September 1, 2006; March 14, 2008 and May 4, 2010.

Claims 1-20 were pending in the present application prior to the above amendment. The Applicant notes with appreciation the indication the allowance of claims 1 and 2. Claims 3 and 4 have been amended to better recite the features of the present invention and new claims 21 and 22 have been added to recite additional protection to which the Applicant is entitled. Claims 5-7 have been withdrawn from consideration by the Examiner. Accordingly, claims 1-4 and 8-22 are currently elected, of which claims 1-4, 8 and 9 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 3, 4, 10, 11 and 14-18 as obvious based on the combination of U.S. Publication No. 2001/0045593 to De Leeuw and U.S. Publication No. 2002/0105058 by Tuttle. Paragraph 3 of the Official Action rejects claims 12 and 13 as obvious based on the combination of De Leeuw, Tuttle and JP 10-135040 to Urano. Paragraph 4 of the Official Action rejects claims 8, 9, 19 and 20 as obvious based on the combination of De Leeuw, Tuttle and U.S. Publication No. 2003/0234294 to Uchihiro. The Applicant respectfully traverses the rejections because the Official Action has not made a *prima facie* case of obviousness and/or that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

With respect to independent claims 3 and 4, the prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Specifically, rejected independent claims 3 and 4 have been amended to clarify "a first insulating film over the substrate, the first insulating film covering the conducting wire and the thin film transistor."

In making the rejection of claims 3 and 4, the Official Action specifically asserts that FIG. 5 of De Leeuw "*is arbitrarily drawn with layer 41 on the bottom, and layer 1 on top, therefore, for the purpose of this rejection, look at FIG. 5 upside-down.*" However, even in this interpretation of De Leeuw, the asserted first insulating film 49 is not provided over the asserted substrate 11. Tuttle does not appear to overcome the above deficiency in De Leeuw.

Because De Leeuw and Tuttle do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained with respect to independent

claims 3 and 4. The secondary reference to Urano does not cure the deficiencies of De Leeuw and Tuttle. Therefore, Applicant believes the rejections of claims 3 and 4 and claims dependent therefrom are not proper.

With respect to independent claims 8 and 9, the prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Specifically, independent claims 8 and 9 recite the claimed feature "*a second insulating film...at least **adjacent to a side** of the conducting wire by interposing the first insulating film therebetween.*"

In making the rejection, the Official Action on page 7, lines 10-14 admits that De Leeuw fails to teach or suggest this feature. For this deficiency, the Official Action allegedly relies on teachings of Uchihiro and Tuttle. However, nowhere in the rejection does it appear to establish with any particularity which teachings within either reference is being relied upon for the bolded feature, or provide any rationale as to a motivation to combine teachings to achieve such a feature.

As set forth in MPEP § 2142, the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. In this regard, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit (KSR International Co. v. Teleflex Inc., 550 U.S. 398, 82 USPQ2d 1385 (2007)). The Court quoting In re Kahn (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396. This has not been done. Accordingly, the rejection is improper on its face.

Because De Leeuw, Tuttle and Uchihiro do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained with respect to

independent claims 8 and 9. Therefore, Applicant believes the rejection of claims 8 and 9 and claims dependent therefrom is not proper.


Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New claims 21-22 have been added to recite additional protection to which the Applicant is entitled. For the reasons stated above, the Applicant respectfully submits that new claims 21-22 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,

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